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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 374

MONROE AUTO EQUIPMENT COMPANY, *Petitioner,*

v.

HECKETHORN MANUFACTURING & SUPPLY COMPANY, *Respondent.*

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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THE QUESTION PRESENTED

The respondent doubts that the Question Presented by the petitioner properly states any issue raised by the decision of the court below holding the Walker patent invalid as a matter of law. The petitioner's question states that the court below in support of its judgment:

> "not only decided disputed matters of primary fact but as well resolved matters of weight and credibility, and drew inferences, all in ways with which other reasonable men could disagree."

The District Court said that it based its holding of invalidity of the Walker patent on:

> "undisputed, documentary evidence upon which the plaintiff had relied; i.e., the patents themselves, their file wrappers, and the plaintiff's own sales records. No factual dispute needed resolution for the court to conclude as a matter of law that the three claims herein were invalid." 214 F. Supp. 704 at 706-707.

In affirming the District Court's judgment that the Walker patent was invalid the Court of Appeals recognized that the question before it was whether the evidence was such that "without weighing the credibility of witnesses" there could be but one reasonable conclusion, namely that reached by the District Court. 332 F. 2d 406 (1964) at 412.

The Court of Appeals pointed out that the resolution of only two factual matters is needed in order to rule, as a matter of law, on the validity of a patent. (332 F. 2d at 411). These are a determination of what the prior art was and what, if any, improvement the patentee has made over the prior art. There is no dispute whatever in the present case about either of these factual questions. The combination of a shock absorber disposed within a coil spring was admittedly old.[1] The sole difference between the patented device and the prior art was the provision of the rubber sleeve between the two metallic parts of the old combination. This is apparent from the Walker patent itself and its file history, and four United States courts have recognized this obvious fact. *Infra*, page 4.

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[1] See for example Plaintiff's Exhibit 52, Appellant's App. 536a.

Consequently, the respondent does not believe that the Question Presented by the petitioner is fairly raised by the record of this case. In reaching the conclusion that the Walker patent was invalid because it claimed an obvious mechanical expedient which did not rise to the level of invention, both Courts below made it clear that it was not necessary to decide any disputed matters of primary fact nor to resolve any matters of weight or credibility nor draw inferences.

SUPPLEMENTAL STATEMENT OF THE CASE

The Walker Patent No. 2,896,938 relates to an improvement in a shock absorber unit for automobiles. The basic unit consists of a metallic telescoping shock absorber around which is mounted a metallic coil spring. See Plaintiff's Exhibit 1A, Appellant's App. 249a. The patentee's improvement consisted of putting a rubber sleeve around the shock absorber to prevent the metal spring from striking the metal shock absorber and causing undesirable noise. The *entire and sole* description of this improvement in the Walker patent is as follows:

> "A sleeve 86 of non-metallic rubber or fibre material fits between adapter 80 and the flange 11a of the dust guard 11."

There is no dispute whatever concerning the fact that the combination of spring and shock absorber is very old in the art[2] or that the alleged improvement is the provision of the rubber sleeve.[3] All of this is apparent from the Walker patent and from prior art patents.

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[2] See for example Plaintiff's Exhibit 52, Appellant's App. 536a.

[3] Petitioner's Brief, page 5.

One of the District Court's conclusions of law was that:

> "There is no patentable invention involved in positioning a rubber sleeve around a shock absorber to prevent a surrounding coil spring from making metal to metal contact with such shock absorber." 204 F. Supp. 249 at 255.

The Court of Appeals for the Sixth Circuit held:

> "We are of the opinion that the use of a rubber sleeve to prevent metal-to-metal contact was an obvious mechanical expediency and cannot rise to the level of invention. Enterprise Manufacturing Company v. Shakespeare Co., 106 F. 2d 800, 803 (C.A. 6), cert. den. 309 U.S. 665, 60 S. Ct. 590, 84 L. Ed. 1012." 332 F. 2d 406 at 413.

The United States District Court for the Southern District of California reached the same conclusion regarding the invalidity of the Walker patent. The Court said:

> "The evidence clearly supports the conclusion that any advance over the prior art would have been obvious to a person skilled in the art and, in particular, there is no patentable invention involved in positioning a rubber sleeve around a shock absorber to prevent metal to metal contact and noise." *Monroe Auto Equipment Co. v. Superior Industries, Inc.*, 220 F. Supp. 941 at 942 (1963).

This judgment was affirmed by the United States Court of Appeals for the Ninth Circuit which said:

> "We agree with the trial court that the prior art anticipated and demonstrated the existence of the shock absorbers, the coil springs, and the sleeve, of various nonmetallic substances; and that their combination was not invention." 332 F. 2d 473 at 479 (C.A. 9th, 1964)

REASONS FOR DENYING THE WRIT

The petition for writ of certiorari to the Court of Appeals for the Sixth Circuit should be denied because the decision of the Court of Appeals is entirely consistent with decisions of this Court holding that patentability is a question of law reviewable on appeal, *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) and petitioner was not prejudiced by the denial of a jury trial because under these decisions the Courts below would have been required to hold the Walker patent invalid as a matter of law even if a jury had returned a verdict that the patent was valid.

The denial of a jury trial is harmless error where there is no issue of fact to submit to a jury, or where the evidence is of such conclusive character that without weighing the credibility of witnesses there can be but one reasonable conclusion. *Forster* v. *Insurance Co. of North America*, 139 F. 2d 875 (C.A. 2, 1944); *Alley* v. *Bessemer Gas Engine Co.*, 262 Fed. 94, 95 (C.A. 5, 1919); *Burke Grain Co.* v. *St. Paul-Mercury Indemnity Co.*, 94 F. 2d 458, 463 (C.A. 8, 1938); *General Tire Co.* v. *Standard Accident Insurance Co.*, 65 F. 2d 237 (C.A. 8, 1933); *Orenstein* v. *The United States*, 191 F. 2d 184 (C.A. 1, 1951); and *Tanimura* v. *The United States*, 195 F. 2d 529 (C.A. 9, 1952).

The same rules are applicable to jury trials in patent cases as those applicable in other cases. *Klein* v. *Burns Mfg. Co., Inc.*, 245 F. 2d 269 (C.A. 2, 1957).

The opinions of both Courts below clearly reveal that the Courts were aware that they could not properly enter a judgment of invalidity of the Walker patent as a matter of law unless the facts necessary to support that

judgment were undisputed or so clearly established that without weighing the credibility of witnesses one could arrive only at the conclusion that the patent was invalid. As indicated above, the judgments of the Courts below holding the Walker patent invalid because it claimed as invention an obvious mechanical expediency were based on undisputed evidence concerning the prior art and the nature of Walker's improvement.

The petitioner questions whether the Court of Appeals was correct in ruling that the application of legal criteria are involved in a determination of patentability (petitioner's Brief, pages 10-11) and argues, in any event, that the determination of patentability must involve an evaluation of petitioner's evidence on commercial success of the Walker patent as well as drawing certain inferences therefrom (petitioner's Brief, pages 11-12).

This Court has held that patentability is a matter of law, and that an appellate court may reverse a judgment that a patent is valid simply on the grounds that the proper standard of invention has not been applied. *Great Atlantic and Pacific Tea Company* v. *Supermarket Equipment Corp.*, 340 U.S. at 154. The concurring opinion by Justices Douglas and Black states:

> "The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law." (340 U.S. at 155)

The analysis by the Court of Appeals for the Sixth Circuit of the factual basis required in order to rule as a matter of law on the question of patentability of an invention is in accord with the definition of patent-

ability appearing in the patent statutes, 35 U.S.C. § 103, The statute states:

> "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The statute does not require an evaluation of commercial success of an invention as a condition for determining patentability but mentions only the two factors on which the Court of Appeals based its judgment. The relevance of commercial success to a determination of patentability was also dealt with by this Court in *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. at 153, where it said:

> "The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability."

THE PETITIONER'S REASONS FOR GRANTING THE WRIT (PETITIONER'S BRIEF, PAGE 8) ARE UNSOUND

a. Petitioner says that it has been denied its right to a jury trial by a decision in conflict with decisions of this Court including *Dairy Queen* v. *Wood*, 369 U.S. 469 (1962) and others. None of the cases cited by petitioner deal with a situation in which a case was tried by the court following denial of a jury trial and wherein the evidence adduced at such trial indisputably supported a judgment as a matter of law.

b. Petitioner argues that the writ should be granted in order to make it clear that jury trial "is applicable

in its full majesty to patent infringement action like others." No one has disputed this, and neither of the Courts below has ruled to the contrary.

c. The decision below is not in conflict with *Slocum* v. *New York Life Ins. Co.*, 228 U.S. 364 (1913) as petitioner states. The facts of this case are altogether different. The *Slocum* case holds that an appellate court cannot re-examine facts which have been earlier determined by a jury as this would be violative of the Seventh Amendment. The issue decided by the *Slocum* case is obviously not involved in this one.

CONCLUSION

The Walker patent has been considered by a total of eight federal judges, and all have agreed that the patent is invalid because the use of a piece of rubber to prevent noisy metal to metal contact simply does not meet the standards of patentability prescribed by this Court in the *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.* case, *supra*. The Courts below have made it clear that their judgment was based on undisputed facts or overwhelming evidence such that without weighing the credibility of witnesses one could only conclude that the Walker patent was invalid as a matter of law. Therefore, the petitioner has not been prejudiced by the denial of a jury trial since in the event of such a trial it would have been necessary for the Court to direct a verdict that the patent was invalid.

Respectfully submitted,

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Certificate of Service

Three copies of the foregoing Brief In Opposition to Petition for Writ of Certiorari have been served on the petitioner by mailing said copies first class airmail, postage prepaid, to petitioner's attorney, William W. Rymer, Esq., 84 State Street, Boston, Massachusetts 02109 this 11th day of September, 1964.

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